

Election & Remarks

In response to the Restriction Requirement listing Inventions I-III, Applicants elect to prosecute claims directed to Invention III, represented by claims 12-30. This election is made with traverse.

The Examiner contends that claims 1-30 are directed to three distinct inventions. They are as follows:

Invention I, claims 1-7, directed to serial-to-parallel or parallel-to-serial data modification in peripheral adapting.

Invention II, claims 8-11, directed to bus interface architecture.

Invention III, claims 12-30, directed to protocol selection in peripheral configuration.

Applicants respectfully submit that the restriction between Inventions I and III is improper and should be withdrawn because the Examiner failed to show "separate utility" as required by M.P.E.P § 806.05(d).

As stated in the Office Action, "[t]he subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable." Office Action, at p. 2 (emphasis added). Here, the Examiner failed to meet the "separately usable" requirement because the Examiner's stated utilities for Inventions I and III are not separate.

In asserting separate utility, the Examiner stated:

subcombination I has separate utility such as converting and transferring data between serial and parallel format Subcombination III has separate utility such as selecting and supporting multiple protocols

Id. Assuming *arguendo* that the stated utilities for Inventions I and III are correct, the reason for restriction is still flawed for several reasons. First, "converting and transferring data between serial and parallel format" is a transfer of data between two formats or protocols. Accordingly, the utility of Invention I is equivalent to the alleged utility of Invention III which is "supporting multiple protocols." Second, claim 1, which is in Group I, specifically recites "one of said plurality of pads is a programmable pad capable of supporting at least two standards," which is similar to "supporting multiple protocols."

Accordingly, the restriction requirement based on M.P.E.P. § 806.05(d) is clearly improper. Applicants respectfully request that the Examiner reconsider and withdraw the restriction.

Respectfully submitted,

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